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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/729,727   | 12/05/2003  | Michael P. Filosa    | 8556-AFP/GDM        | 1314             |
| 20349  | 7590        | 11/03/2004           | EXAMINER            |                  |
| POLAROID CORPORATION<br>PATENT DEPARTMENT<br>1265 MAIN STREET<br>WALTHAM, MA 02451 |             |                      | FAISON, VERONICA F  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1755                |                  |

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |                                      |  |
|------------------------------|---------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/729,727  | <b>Applicant(s)</b><br>FILOSA ET AL. |  |
|                              | <b>Examiner</b><br>Veronica F. Faison | <b>Art Unit</b><br>1755              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7-12, 14, 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Elhard et al (US 2002/0001847).

Elhard et al teach a color-forming composition which comprises a solvent absorbing material that is generally a polymer, a color former compounded with the solvent absorbing material, where the color-former functions as a metal chelating agent; and metal ion capable of forming a chelate complex with color-former as the solvent-absorbing material absorbs a solvent, resulting in a detectable color change of the composition (abstract and page 1 para.0006). Two types of color formers may be used: one which produces a permanent color change that is not reversed by removal of the solvent from the solvent absorbing material; and another which provides for a reversible color change when the absorbed solvent is removed from the outer covering of the object (page 1 para. 0009). Permanent color change former and reversible color formers are present in the amount of 0.1 to about 2.5 percent by weight and may also

be mixtures (page 1 para. 0010). The reference further teaches that the color forming compositions are white or colorless after initial processing and do not change until solvent is absorbed. These color forming composition are essentially "aquachromic" meaning that color change occurs upon exposure to water (page 2 para. 0012 and 0019). The reference further teaches a reversible color-forming composition is augmented by a fixative that renders the color development more or less permanent (page 3 para. 0032). The preferred fixatives are derivatives of either salicylic acid or alternatively derivatives of bisphenol-A. These formulations may also include a source of H<sup>+</sup> or OH<sup>-</sup> ions to aid in the hydrolysis of the fixative (page 4 para. 0034). The color-forming composition may be used as the outer cover for golf balls (page 4 para. 0035). The composition as taught by Elhard et al appears to anticipate the claimed invention.

Claims 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sano et al (US Patent 5,922,115).

Sano et al teach a decolorizable ink consisting of an ink composition dispersed in a solvent, the ink composition comprising a color former, a developer and a decolorizer, wherein the color former and developer are in a colored state by interaction between them and the decolorizer has a property to dissolve preferentially the developer when the ink composition is melted (abstract and col. 2 lines 55-67). The color former includes electron-donating substances such as leucoauramines and Rhodamine B lactams and the color formers may also be present alone or in combination of two or more species (col. 3 line 46-col. 4 line 25). The developer includes acidic compounds that may also be present alone or in combination of two or more species (col. 4 lines 19-

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25). The reference further teaches that a binder may be present in the composition (col. 8 lines 62-64). The composition as taught by Sano et al appears to anticipate the claimed invention.

Claims 1-4, 6-7, 11, 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Winskowicz (US Patent 6,358,160).

Winskowicz teaches a golf ball which changes color or other indicia after significant immersion in water to indicate that the ball has been recovered. The reference also teaches that the imprints on the ball are made with a water activated ink which either appears or disappears upon the immersion of the golf ball in water (abstract and col. 1 line 61-col. 2 line 5). The reference further teaches that the dyes that may be used should water-soluble and may vary from a broad range of industrial dye material (col. 5 lines 18-34). The reference teaches that resins (binder) may be combined in the ink composition (col. 10 lines 6-10). The composition as taught by Winskowicz appears to anticipate the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winskowicz (US Patent 6,358,160).

Winskowicz is described above, but fails to specifically exemplify the use of resins (binder) and acid dye and developer as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the resins (binder) and acid dye as claimed by applicant as Winskowicz also discloses the use of resins (binder) but shows no example incorporating them and the reference also teaches broad range industrial dye material which is broad enough to encompass acid dye absence evidence to the contrary.

Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sano et al (US Patent 5,922,115).

Sano et al is described above, but fails to specifically exemplify the use of base sensitive components as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the base sensitive components as claimed by applicant as Winskowicz also discloses the use of base sensitive components but shows no example incorporating them.

### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the Examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Veronica F. Faison